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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,096	10/06/2000	Howard A. Schechtman		1117

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KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
SUITE 900
WASHINGTON, DC 20005

EXAMINER

HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,096

Applicant(s)

SCHECHTMAN ET AL.

Examiner

Lalita M Hamilton

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Recd

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 2002/0032656) in view of Kawan (US 2002/0065712).

Chen discloses a method and means for providing automatic teller machine services to multiple financial institutions comprising receiving at an automatic teller machine (ATM) a transaction request from an ATM user, wherein the ATM comprises a display screen, determining that the ATM user comprises a non-customer, displaying information related to an incentive program for non-customers on the display screen, wherein the information prompts the ATM user for a response, and receiving the response from the ATM user (p.2, 10 and p.6, 47); comprising tracking the electronic transactions of the ATM user (p.6, 47); the ATM comprises an ATM operated by a first

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financial institution (p.2, 10); determining that the ATM user comprises a non-customer comprises determining that the ATM user is not a customer of the first financial institution (p.2, 10); determining that the ATM user comprises a non-customer comprises accessing a network associated with the first financial institution (p.2, 10); the transaction request comprises a bank identification number (BIN) (p.6, 53); the receiving at the automatic teller machine (ATM) the transaction request from the ATM user comprises receiving an ATM card of the ATM user (p.6, 49); tracking the ATM user's electronic transactions on a second ATM associated with the first financial institution (p.6, 47); reducing the convenience fee of the ATM user (p.2, 10); eliminating the convenience fee of the ATM user is carried out on a periodic basis (p.2, 13); the periodic basis comprises at least one of the following: every fifth transaction session, every tenth transaction session, every transaction session, and every other transaction session (p.2, 13); enrolling the ATM user in the incentive program comprises recording the BIN of the ATM user (p.6, 53-54); displaying an advertisement to the ATM user (p.6, 47); recording an electronic transaction of the ATM user in a transaction database associated with the ATM user (p.6, 47); selecting the advertisement based on the transaction database associated with the ATM user (p.6, 47); and the ATM comprises an off-premises ATM (p.2, 10). Chen does not disclose enrolling the ATM user in the incentive program; assigning a pre-selected number of points to an account of the ATM user in response to a pre-selected event; receiving a point-balance request from the ATM user, accessing the account of the ATM user, wherein the account comprises a point balance of the ATM user, and providing the point balance of the ATM user to the

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ATM user; the information related to the incentive program for non-customers comprises information encouraging the ATM user to join the incentive program; the response comprises at least one of the following: an e-mail address and a telephone number; providing the ATM user with further opportunities to earn a pre-selected number of points; providing an opportunity to the ATM user to redeem the points for at least one of the following: goods, services, discounts, credit, and cash; reducing the convenience fee of the ATM user comprises eliminating the convenience fee of the ATM user; establishing an incentive program account for the ATM user; assigning a pre-selected number of points to an incentive program account of the ATM user; receiving a request to view the number of points in the incentive program account of the ATM user and displaying the number of points associated with the ATM user; accessing the incentive program account of the ATM user, wherein the incentive program account comprises the number of points associated with the ATM user; displaying an advertising-view inquiry comprising an invitation to view an advertisement in exchange for the addition of points to the incentive program account of the ATM user and receiving an affirmative response to the advertising-view inquiry; receiving an indication from the ATM user that the ATM user viewed the advertisement, and, after receiving the indication from the ATM user that the ATM user viewed the advertisement, assigning a second pre-selected number of points to the incentive program account of the ATM user; determining if the ATM user is eligible for an incentive award; determining if the ATM user is eligible for the incentive award comprises comparing the number of points associated with the ATM user with a third pre-selected number of points; providing the

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ATM user with the award; the award comprises forgiveness of an ATM use convenience fee; or enrolling the ATM user in the incentive program comprises contacting the ATM user using data in the response. Kawan teaches a method and means for tracking smart card loyalty points comprising enrolling the ATM user in the incentive program (p.1, 11 and p.3, 31); assigning a pre-selected number of points to an account of the ATM user in response to a pre-selected event (p.3, 31-32); receiving a point-balance request from the ATM user, accessing the account of the ATM user, wherein the account comprises a point balance of the ATM user, and providing the point balance of the ATM user to the ATM user (p.3, 30); the information related to the incentive program for non-customers comprises information encouraging the ATM user to join the incentive program (p.3, 31); the response comprises at least one of the following: an e-mail address and a telephone number (p.3, 31); providing the ATM user with further opportunities to earn a pre-selected number of points (p.3, 31-32); providing an opportunity to the ATM user to redeem the points for at least one of the following: goods, services, discounts, credit, and cash (p.2, 16); reducing the convenience fee of the ATM user comprises eliminating the convenience fee of the ATM user (p.2, 13); establishing an incentive program account for the ATM user (p.31, 31); assigning a pre-selected number of points to an incentive program account of the ATM user (p.3, 31-32); receiving a request to view the number of points in the incentive program account of the ATM user and displaying the number of points associated with the ATM user (p.2, 16); accessing the incentive program account of the ATM user, wherein the incentive program account comprises the number of points associated with the ATM user (p.2,

16); displaying an advertising-view inquiry comprising an invitation to view an advertisement in exchange for the addition of points to the incentive program account of the ATM user and receiving an affirmative response to the advertising-view inquiry (p.3, 30-32); receiving an indication from the ATM user that the ATM user viewed the advertisement, and, after receiving the indication from the ATM user that the ATM user viewed the advertisement, assigning a second pre-selected number of points to the incentive program account of the ATM user (p.3, 30-32); determining if the ATM user is eligible for an incentive award (p.3,30-32); determining if the ATM user is eligible for the incentive award comprises comparing the number of points associated with the ATM user with a third pre-selected number of points (p.3, 30-32); providing the ATM user with the award; the award comprises forgiveness of an ATM use convenience fee (p.2, 13); and enrolling the ATM user in the incentive program comprises contacting the ATM user using data in the response (p.3, 31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the method and means of enrolling the ATM user in the incentive program; assigning a pre-selected number of points to an account of the ATM user in response to a pre-selected event; receiving a point-balance request from the ATM user, accessing the account of the ATM user, wherein the account comprises a point balance of the ATM user, and providing the point balance of the ATM user to the ATM user; the information related to the incentive program for non-customers comprises information encouraging the ATM user to join the incentive program; the response comprises at least one of the following: an e-mail address and a telephone number; providing the ATM user with further opportunities to

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earn a pre-selected number of points; providing an opportunity to the ATM user to redeem the points for at least one of the following: goods, services, discounts, credit, and cash; reducing the convenience fee of the ATM user comprises eliminating the convenience fee of the ATM user; establishing an incentive program account for the ATM user; assigning a pre-selected number of points to an incentive program account of the ATM user; receiving a request to view the number of points in the incentive program account of the ATM user and displaying the number of points associated with the ATM user; accessing the incentive program account of the ATM user, wherein the incentive program account comprises the number of points associated with the ATM user; displaying an advertising-view inquiry comprising an invitation to view an advertisement in exchange for the addition of points to the incentive program account of the ATM user and receiving an affirmative response to the advertising-view inquiry; receiving an indication from the ATM user that the ATM user viewed the advertisement, and, after receiving the indication from the ATM user that the ATM user viewed the advertisement, assigning a second pre-selected number of points to the incentive program account of the ATM user; determining if the ATM user is eligible for an incentive award; determining if the ATM user is eligible for the incentive award comprises comparing the number of points associated with the ATM user with a third pre-selected number of points; providing the ATM user with the award; the award comprises forgiveness of an ATM use convenience fee; and enrolling the ATM user in the incentive program comprises contacting the ATM user using data in the response,

as taught by Kawan into the method and means disclosed by Chen, to provide additional incentive for non-customers to use a bank's ATM machine.

Provisional Application Listed on PTO-892 form

... If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

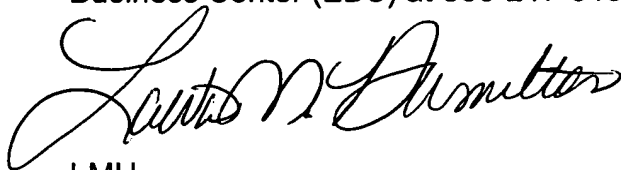
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "L. M. H.", is written over the printed name "LMH".

LMH